

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Yoshio SASAKI et al.

Application No.: 10/076,602

Filed: February 19, 2002

For: RECORDING MEDIUM,  
INFORMATION RECORDING  
APPARATUS, INFORMATION  
RECORDING METHOD,  
INFORMATION RECORDING  
MEDIUM, AND RECORDING  
PROGRAM

Confirmation No.: 2300

Group Art Unit: 2627

Examiner: Kim K. Chu

Commissioner for Patents  
U.S. Patent and Trademark Office  
**Customer Window, Mail Stop Issue Fee**  
Alexandria, VA 22314

**SUBMISSION OF U.S. OFFICE ACTION**

Sir:

Applicants bring to the attention of the Examiner the attached U.S. Office Action dated February 21, 2008 which issued in the above identified application's continuation U.S. patent application No. 11/321,630 ("the '630 application"). Applicants respectfully bring to the Examiner's attention the Office Action as it relates to the above-identified application.

The attached U.S. Office Action dated February 21, 2008 applies particular claims of the above-identified application no. 10/076,602 in a double patenting rejection against claims 14-19 of the '630 application.

This submission does not represent that a search has been made or that no better art exists and does not constitute an admission that the cited document is material or constitutes "prior art."

This submission does not represent that a search has been made or that no better art exists and does not constitute an admission that the cited document is material or constitutes "prior art." If it should be determined that the cited document does not constitute "prior art" under United States law, Applicants reserve the right to present to the Office the relevant facts and law regarding the appropriate status of such document.

Applicants further reserve the right to take appropriate action to establish the patentability of the disclosed invention over the cited document, should the document be applied against the claims of the present application.

**Except** for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this Application, including fees due under 37 C.F.R. § 1.16 and 1.17 which may be required and including any required extension of time fees, *or* credit any overpayment to Deposit Account No. 50-0573. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

**DRINKER, BIDDLE & REATH LLP**

By:



Paul A. Fournier

Registration No. 41,023

Dated: April 24, 2008

**CUSTOMER NO. 055694**

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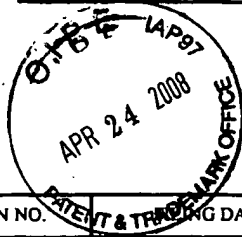
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# UNITED STATES PATENT AND TRADEMARK OFFICE



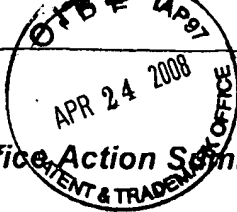
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APPLICATION NO.	FILED DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/321,630	12/30/2005	Yoshio Sasaki	041465-5140-01	2023
9629 7590 02/21/2008 MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004			EXAMINER CHU, KIM KWOK	
			ART UNIT 2627	PAPER NUMBER
			MAIL DATE 02/21/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**



Application No.

11/321,630

Applicant(s)

SASAKI ET AL.

Examiner

kim-kwok CHU

Art Unit

2627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on Amendment filed on 11/15/2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 14-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/30/2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 10/076,602.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**Response to Remarks**

1. Applicant's Amendment filed on December 28, 2007 have been fully considered:

The newly amended Claims 14, 18 and 19 are being rejected under the judicially created doctrine of obviousness-type double patenting.

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**Double Patenting**

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 14-19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 3 of Application 10/076,602. Although the conflicting claims are not identical, they are not patentably distinct from each other.

(a) with respect to the present amended claim 1, the '602 Application's claim 1 has every limitation of the present amended claim 14. For example, in present Claim 14, last second line, the claimed limitation "parameter information corresponding to a function of the information recording apparatus" is an obvious variation of the feature cited in Claim 1, of the '602 Application, lines 8 and 9, as "information containing optimization information for optimizing a recording state" because the "optimization information" can be considered as a parameter information and the "optimization a recording state" is a function of the information recording apparatus.

(b) Similarly, with respect to the present amended claims 18 and 19, the '602 Application 's claim 1 has every limitation of the present amended claims 18 and 19.

(c) with respect to the present dependent Claim 15, the '602 Application 's claim 3 has every limitation of the present Claim 15.

(d) with respect to the present dependent Claims 16 and 17, the '602 Application's claim 1, last two lines, claims the present limitation of "identification information and the parameter information are recorded at a plurality of positions".

4. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Kim CHU whose telephone number is (571) 272-7585 between 9:30 am to 6:00 pm, Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa Nguyen, can be reached on (571) 272-7579.

The fax number for the organization where this application or proceeding is assigned is (571) 273-8300

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished application is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9191 (toll free).

Kim-Kwok CHU *2/11/08*  
Examiner AU2627  
February 11, 2008  
(571) 272-7585

*[Signature]*  
HOA T. NGUYEN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600  
*2/18/08*